

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-3 and 5-11 are now present in this application. Claims 1, 10 and 11 are independent. Claim 4 was previously canceled. Claims 12-20 have been previously canceled without prejudice to presenting those claims in a separate, e.g., a divisional, application. By this amendment, the specification is amended, and claim 1 is amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Restriction and Election of Species Requirements

The Examiner has made the Restriction and Election of Species Requirement final, has withdrawn claims 10 and 11 from further consideration.

Restriction was required between:

Invention I, claims 1-3, 5, 9 and 10, directed to a tilt controlling method, classified in Class 369, subclass 53.19; and

Invention II, claim 11, drawn to a tilt controlling apparatus comprising a RF and servo error producing unit, a servo controlling unit and a servo driving unit, classified in Class 369, subclass 44.11.

The Office states that inventions I and II are related as process and apparatus for its practice and that "the claimed method of controlling tilt can be practiced by another and

materially different apparatus, such as one not having a detecting block for detecting the maximum and minimum values of a focus error per one rotation of a disk.”

Applicant initially responds by noting that the Examiner has already examined this specific feature on its merits because this feature was included in claim 12 that was fully examined on its merits in the Office Action dated September 20, 2005 (in paragraph 10 found on pages 9 and 10 of that Office Action).

MPEP § 803 clearly states that even if the application contains independent and distinct invention, if the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits.

The outstanding Office Action attempts to address the issue of whether there is no serious burden on the Examiner by stating that the inventions are distinct and would require a different field of search. Applicant respectfully submits that method and apparatus claims are typically classified and searchable in the very same subclasses of most USPTO Classes, and whether or not they are distinct as different statutory classes of invention is irrelevant to whether the search for a method of use and an apparatus is substantially different, especially where most methods and apparatuses for carrying out those methods are classified in the very same classes and subclasses. Furthermore, because the Examiner has already searched (or is supposed to have searched) any additional fields of search required to make a reasonably comprehensive search of the restricted-out apparatus claims, there is no serious burden on the examiner because the examiner has already presumably made a reasonably comprehensive search of the apparatus subject matter.

In other words, because the Examiner has completely addressed the features found in currently pending claim 11 in a previous Office Action on the merits, the Examiner has not demonstrated that the search and examination of the entire application cannot be made without serious burden, especially where the Examiner has fully examined this claimed subject matter on its merits. Thus, the Examiner must examine claim 11 on its merits along with the other previously examined claims, i.e., all other pending claims.

Moreover, Applicant has already paid for an examination of the subject matter in issue in currently pending claim 11 (which is actually a combination of previously pending, and examined, claims 11 and 12), and have paid the equivalent of a filing fee for another application by filing this Request for Continued examination (RCE). It is fundamentally unfair to require Applicant to file yet another Application to have the same subject matter that was already claimed and examined, examined again.

Applicant respectfully submits that this attempt to get Applicant to file yet another application in addition to this Request for Continued Examination (RCE) to have the subject matter of the pending claims examined, when that claimed subject matter has already been examined, completely violates Applicant's fundamental substantive and procedural due process rights under the Administrative Procedures Act. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000), as well as MPEP §707.07(a).

**This Examiner's response to this is that Applicant has not provided a legal basis for this argument. Applicant respectfully submits that this is an equitable argument and**

**arguing that it is not a legal argument does not address it on its merits as an equitable argument as required by MPEP §707.07(f) and, for this reason alone, the restriction is improper and should be withdrawn.**

This Office Action goes even farther, however, and requires that if Group I is elected, that Applicant additionally elect between two allegedly “independent or distinct” species. However, the Office Action fails to provide any objective factual evidence that the two species are independent, i.e., it fails to demonstrate, or even allege, that these two species are disclosed without any relationship therebetween, or if there is a disclosed relationship therebetween, provide a discussion of why the disclosed relationship does not prevent restriction, as required by MPEP §808.01(a). Nor does the Office Action provide any reasons why these two species are distinct. For these reasons alone, the election of species requirement is improper and should be withdrawn.

In response to this argument, the Office Action states that the two species present mutually exclusive embodiments. Applicant respectfully disagrees, because both sets of claims recite essentially the same features, differing only in whether those features are recited in terms of an apparatus with specific features or a method with steps to carry out those features. The overlap of subject matter is substantial.

Furthermore, this election of species requirement is improper because the Examiner has already examined claims directed to both species and has provided no evidence that a serious administrative burden exists to continue to examine that subject matter in the pending Continued Examination of this Application.

The response to this argument is that 37 CFR §1.142 states that one may make a restriction requirement at any time before final action. Applicant respectfully submits that just because something is permitted does not mean that it is necessarily proper, and because it overlooks the explicit statement in MPEP §803 that even if restriction is proper, it should not be made where there is no special burden on the Examiner to examine all of the claims. Thus it is clear that this rationale for maintaining the restriction clearly ignores the aforementioned mandatory statement in the MPEP.

Accordingly, the election /restriction requirement is improper and should be withdrawn.

**Should the Examiner decide not to withdraw the restriction requirement and decide not to examine all pending claims in the next Office Action, then Applicant requests that this request for reconsideration of the restriction and election of species requirements and withdrawal of claims 10 and 11 from consideration be treated as a Petition under 37 CFR §1.181 to the Commissioner to order the Examiner to withdraw the restriction and election of species requirements and examine all pending claims on their merits.**

#### Objection to the Specification

The specification is objected to because on page 7, line 8, it discloses "a RE signal." This objection is traversed based on the amendment of the specification by changing "a RE signal" in page 7, line 8 to read: - - an FE signal - -. Similarly, on page 10, line 19, "track of the RE signal" is being changed to read: - - track of the FE signal - -.

Although Applicant appreciates the helpful suggestion by the Examiner to correct "RE"

in the specification, Applicant respectfully submits that the suggestion to change "RE to - - RF - -" on page 7, line 8 is incorrect. Applicant inadvertently stated "RE" instead of - - FE - - in the three instances noted above. Support for the changes is found in the Application as originally filed. For example, whereas the brief description of the drawings found on page 7, states that Fig. 4 is a detailed flow chart of tilt control using a RE signal of the invention, the detailed description of Fig. 4 found on page 11, starting on line 19, clearly states that Fig. 4 is a detailed flow chart of tilt control using the FE signal according to the invention. Similarly, whereas the brief description of drawing Figs. 3A to 3D in line 7 on page 7, states that Figs. 3A to 3D show track waveforms of RE signals, inspection of Fig. 4 clearly reveals FE reference levels, but no RF reference levels, and the detailed description of Figs. 3A to 3D on page 11 only mentions FE signals.

Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Rejections under 35 USC §112, First Paragraph

Claims 1-3 and 5-9 stand rejected under 35 USC §112, first paragraph, for lack of enablement. This rejection is respectfully traversed.

Initially, Applicant respectfully submits that the Office Action does not make out a *prima facie* case of lack of enablement of the invention recited in claims 1-16.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims so as to enable one skilled in the pertinent art to make and

use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. *See United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), *cert. denied*, 109 S.Ct. 1954 (1989); *In re Stephens*, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976). As framed by our reviewing court, the dispositive issue with regard to the first paragraph rejection is whether the disclosure is sufficient to enable one of ordinary skill in the art to practice the claimed invention. *See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

In order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *See In re Wright*, 999 F.2d 1557, 1561-2, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 USC 112, first paragraph unless there is a reason for doubting the objective truths of the statements contained in the disclosure which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make or use will be proper on that basis. *See In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971).



Once the Examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the Applicant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. *See In re Brandstadter*, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the determination of enablement, the Examiner shall consider the original disclosure and all evidence in the record, weighing evidence that supports enablement [the appellant may attempt to overcome the Examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellant may also submit factual affidavits under 37 CFR 1.132 or cite references to show what one skilled in the art knew at the time of filing the application against evidence that the specification is not enabling.

Thus, the dispositive issue is whether the Applicant's disclosure, considering the level of skill in the art as of the date of the Applicant's application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. The threshold step in resolving this issue is to determine whether the Examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement.

Factors to be considered by an Examiner in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of guidance or direction presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *See In re*



Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), citing Ex parte Formal, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

The Office Action states that “there is no disclosure on how to detect a ‘track’ of a focus error ‘for maximizing an RF signal or minimizing jitter.’” Applicant respectfully disagrees for the following reasons:

Firstly, the claim language in issue is set forth in the paragraph bridging pages 3 and 4 of Applicant’s originally filed specification as an object of Applicant’s invention.

Secondly, Applicant expressly discloses, on page 10 that “[T]he track of the RE signal is obtained at a point where the RF bright envelope is the maximum (Fig. 2B) while the tilt controlling unit 43d is uniformly wobbled about a reference point or center after the focus and tracking of the optical disk 10 are initialized and then the focus and tracking are on (Fig. 2A). The track can be replaced with a tilt error for tilt control of the optical disk, and accordingly the tilt can be controlled through the tilt controlling unit with the center as a tilt controlling reference voltage (Fig. 2C). Meanwhile, the jitter features of the optical disk 10 are considered to obtain the track of the FE signal at the minimum value of the jitter so that tilt control can be performed in the foregoing fashion.”

Thirdly, Applicant has amended claim 1 by changing “detecting a track of a focus error for maximizing an RF signal” to read: - - detecting a track of a focus error at the maximum value of an RF signal”, and by changing “minimizing jitter” to read: - - [detecting a track of focus error] at the minimum value of jitter - - in claim 1 to place the language in issue in more idiomatic English.

This language is supported in the last paragraph of page 10 and in the first paragraph on page 11 of the specification.

The Office Action continues by speculating that “there is no disclosure on how to calculate a variation per track of the focus error by using the maximum and minimum values of the focus error.” Applicant strongly disagrees with this conclusion that is not supported by any objective factual evidence of what is known in this regard by one of ordinary skill in the art.

In this regard, Applicant respectfully submits that the disclosure is directed to one of ordinary skill in the art who is able to calculate the variation based on the detected maximum and minimum values of the focus error, bearing in mind that focus error per track indicates the amount of focus error across a particular track, each track being one of a number of concentric circles formed on a disc. Moreover, because the Office Action has not even addressed the aforementioned “Wands” factors, this rejection is fundamentally flawed and improper.

The Office Action also speculates that Applicant does not sufficiently disclose how a spindle motor would be operated to calculate a variation per track. Applicant strongly disagrees with this speculative conclusion and respectfully submits that spindle motor operation is well known in the art as are techniques for detecting focus error. It should be remembered that the burden of making a *prima facie* case is on the Office and absent any objective factual evidence presented to support these wholly speculative conclusions, the Office Action fails to make out a *prima facie* case of lack of enablement. This is especially evident due to the complete failure of the Office Action to present any evidence relative to the “Wands” factors discussed, *supra*.

Applicant also respectfully submits that it is well known in the art how to calculate focus error and from that to calculate a variation in focus error for a particular track, especially where different information is often recorded and accessed on optical discs on a cluster (made up of a number of tracks) and/or track-by-track basis. As explained in Applicant's disclosure, focus error is determined, for example, "from the electric signals through astigmatism  $\{(a+c)-(b+d)\}$ " – see page 9, lines 2-7. Applicant also encloses a copy of a 2001 article entitled, "Development of a low-cost autofocusing probe for profile measurement" by Fan et al. published in Meas. Sci. Technol., vol. 12, pages 2137-2146, which explains the astigmatic method of obtaining a focus error curve. Moreover, optical disc recording/reading technology is well known

Thus, the Office Action fails to make out a *prima facie* case of lack of enablement of the claimed invention.

Reconsideration and withdrawal of this rejection are respectfully requested.

#### Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

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Art Unit 2652  
Reply dated February 23, 2007

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Reply to September 25, 2006 Office Action  
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If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Applicant respectfully petitions under the provisions of 37 C.F.R. §1.136(a) and §1.17 for a two-month extension of time to February 20, 2006 in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of \$450.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Enclosure: Fan et al., "Development of a . . . probe for profile measurement," Meas. Sci. Technol., vol. 12 (2001), pages 2137-2146.